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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,733	08/30/2000	Alejandro M. Pilato	11725-46001	2432

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EXAMINER

VINCENT, DAVID ROBERT

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/650,733

Applicant(s)

PILATO, ALEJANDRO M.

Examiner

David R. Vincent

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-139 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-139 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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***Response to Arguments***

1. In view of the Appeal Brief and 1.132 filed on 10/28/04, PROSECUTION IS HEREBY REOPENED. A non-final action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-113, and 138 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written

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description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example:

Claims 1, and 138 specify "demonstrating" that more than one activity of the agent is "transparent".

Although the applicant specifies the need for demonstrating transparency (pg. 9, lines 20-21; pg. 10, lines 4-5; pg. 10, lines 22-23) the applicant has only defined demonstrating as including an explanation of the activities of the agent and that the demonstration can explain how the client might be enabled by the agent to access information and/or monitor activities of the agent (pg. 17, line 28-pg. 18, line 2). Therefore it is the examiner's position that demonstrating transparency was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 114-135, 137, 139 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For example: claim 114, line 1, specifies "a client", line 2 specifies "corporate clients", and line 4 specifies "each client". Using this phrasing is not merely a multiple antecedent basis problem, it leaves the reader confused as to when the claim is referring to "corporate clients" and when the claim(s) are referring to end-user clients (the real customers). The specification does not clarify this point because it has the same problem. When reading the specification one cannot tell when the spec. is referring to "corporate clients" as in service providers and/or when the spec. is referring to end-user clients (the real customers).

Claims 115-118, specify client but the metes and bounds of these limitations cannot easily be determined. Who is or is not the client in these claims, and any claims that specify client.

**Note**

4. The term "transparent" in, e.g., claims 1, and 138 is used by the claim to mean "enabling the communication of information

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and/or the access to information across a network"  
(specification, pg. 7, lines 10-11), while the accepted meaning is "free from pretense or deceit or easily detected or seen through." Is this how the applicant really wants the term interpreted?

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 114-126, 129, 135, 137, 139 are rejected under 35 U.S.C. 102(b) as being anticipated by Underwood (US 5,873,066).

Underwood discloses a computer assisted method (Fig. 2) for a client (customers or end users, ABC company, Figs. 6-13) to outsource financial functions (not further defined, reads on various types of insurance policies or providing money for insurance claims) to an agent (J. Smith Co., Fig. 7; insurance wholesalers, col. 1, lines 51-59) representing a plurality of corporate clients (Acme Ins. Company, Fig. 7; insurance companies that are providing policies such as re-insurance to the underwriter, or producer, Fig. 7) comprising providing financial

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information (e.g., prices or quotes) of each client (reads on the corporate clients such as Acme) to a computer of the agent (Fig. 2, cols. 2-7), enabling the agent to determine an action based on risk (e.g., Fig. 8; col. 5, lines 1-55), allowing agent to take action (Fig. 12; accept, decline, and/or issue letters, col. 4, lines 41-67), as specified in claims 114, 137, and 139; receiving risk management data (e.g., Fig. 8; col. 5, lines 1-55), as specified in claim 115; receiving agents analysis (reads on issue letters col. 4, lines 41-67 or Fig. 12), as specified in claim 116; receiving action instruction or recommendation (Fig. 12; accept, decline, and/or issue letters, col. 4, lines 41-67), as specified in claims 117-118; receiving notification (Fig. 12; or issue letters, col. 4, lines 41-67), as specified in claims 119-120; receiving data across a network (Fig. 2), as specified in claim 121; monitoring activities across network (col. 4, lines 64-67), as specified in claims 122-123; requesting notification (not further defined, reads on either the agent requesting data about a new insurance carrier Fig. 8 or an insured party requesting a policy), as specified in claims 124-125; reasons (col. 4, lines 60-67), as specified in claim 126; providing financial information to the agent (e.g., prices or quotes), as specified in claims 129, and 135.

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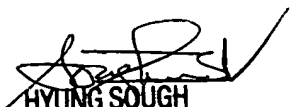
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David R. Vincent whose telephone number is 571 272 3080. The examiner can normally be reached on M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on 571 272 6799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David R Vincent  
Primary Examiner  
Art Unit 3628

May 18, 2005

  
HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
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